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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,184	12/14/2001	Yang-Pioung Kim	946,038	1088
24106	7590	08/20/2007	EXAMINER	
EGBERT LAW OFFICES 412 MAIN STREET, 7TH FLOOR HOUSTON, TX 77002			JACKSON, MONIQUE R	
ART UNIT		PAPER NUMBER		
1773				
MAIL DATE		DELIVERY MODE		
08/20/2007		PAPER		

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/022,184
Filing Date: December 14, 2001
Appellant(s): KIM, YANG-PIOUNG

MAILED
AUG 20 2007
GROUP 1700

Andrew W. Chu
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/12/07 appealing from the Office action mailed 12/27/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct. Note: the status is the final line of the section. To summarize, Claims 1-10 are cancelled and Claims 11-12 are pending and on appeal.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,523,335	WHYZMUZIS et al	6-1996
4,483,712	MURPHY	11-1984
5,656,701	MIYAMOTO et al	8-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 11 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hein, III et al (USPN 5,542,529) alone or in view of Whyzmuzis et al (USPN 5,523,335) or Murphy (USPN 4,483,712) or Miyamoto et al (USPN 5,656,701) for the reasons recited in the office action dated 7/27/05 and restated below.

Hein et al teach a high barrier packaging material comprising a core of aluminum metallized polyethylene terephthalate, an ink layer on the metallized and/or unmetallized side of the PET core and outer transparent heat seal layers which are preferably polyesters such as PET, wherein the ink layer may be formed on both sides of the metallized PET core, the entire surface of which may be covered by transparent or opaque (*i.e.* “*light protecting*”) inks of various colors (Abstract; Col. 5, lines 1-7; Col. 7, line 19-Col. 8, line 19; Col. 8, lines 30-47.) Hence, Hein et al teach the following packaging structure: transparent PET heat seal/opaque ink layer/metallized PET/opaque ink layer/transparent PET heat seal with no other layers therebetween which is equivalent to the instantly claimed structure of transparent PET/adhesive layer/aluminum metallized PET/ink layer/hot melt layer wherein one of the opaque ink layers reads upon the colored adhesive layer directly applied to the aluminum-deposited PET film and the two outer transparent PET heat seal layers read upon the transparent PET layer overlaying the adhesive layer and the hot melt layer on the ink layer of the instantly claimed invention. Hence, the

Examiner notes that the only difference between Hein et al and the instant invention is the white color of the adhesive layer and ink layer.

Though Hein et al specifically teach that a yellow ink layer can be printed on the entire surface of the metallized PET core or other colors may be utilized with various inks listed in the examples, Hein et al do not specifically teach the use of white ink layers over the entire surface. However considering Hein et al teach that various colored opaque inks may be utilized, one skilled in the art at the time of the invention would have been motivated to utilize white ink layers, an obvious species of colored opaque ink, in the invention taught by Hein et al wherein a white ink layer over the entire surface of the metallized PET would function as an adhesive layer between the metallized PET and the outer transparent PET heat seal and hence reads upon the broad limitation "adhesive". Further, though Hein et al do not specifically teach that the ink compositions are "two-component" adhesives of white color as instantly claimed, the Examiner takes the position that a white opaque ink layer would read upon the instantly claimed "two-component adhesive of white color" considering the ink layer would be formulated from a binder material (*first component*) and a pigment (*second component*), in this case, a white pigment. Alternatively, one having ordinary skill in the art at the time of the invention would have been motivated to utilize any conventional laminating ink composition wherein two-part or two-component laminating inks are known to provide excellent adhesion and printing on plastic films such as PET films as taught by Whyzmuzis et al or Murphy or Miyamoto et al, wherein the two-component laminating adhesives may comprise pigments of various colors including white pigments.

(10) Response to Argument

The Examiner first notes that all three headings under the Appellant's "ARGUMENT" section are directed to the sole ground of rejection.

I. OVERVIEW

The Appellant argues that the instant invention is not made obvious by the prior art or combinations and that independent Claim 11 now recites limitations regarding coating the film with white ink of a "particular type" that is no longer made obvious by the prior art. However, the Examiner respectfully disagrees and maintains that the invention is obvious for the above reasons and notes that Claim 11 provides no additional limitations with regards to the "particular type" of white ink to differentiate it from the teachings of Hein.

II. THE INVENTION IS MADE OBVIOUS BY THE PRIOR ART

A. THE INVENTION IS MADE OBVIOUS BY THE HEIN PATENT ALONE

The Appellant argues that the Hein patent fails to disclose any adhesive layer whatsoever, multiple adhesives, nor the relationship between the adhesive layers as now claimed wherein the adhesive is applied directly onto one side of the aluminum-deposited layer without any layer therebetween. However, the Examiner respectfully disagrees. Considering the instant claims are interpreted in their broadest sense in the art and considering the ink layer taught by Hein is in between the metallized PET core and the outer transparent PET heat seal layer, the ink layer is an adhesive layer given that it adheres the outer transparent PET to the metallized PET core, especially when the ink layer is over the entire surface of the metallized PET core as taught by Hein. Further, Hein specifically recite at col. 4, lines 52-54 that inks with adhesion characteristics are preferred. Hence, the colored ink layer taught by Hein is an adhesive layer.

In terms of the layer structure and relationship between the layers, the Examiner notes that Hein specifically teaches the following structure:

transparent PET heat seal/opaque ink layer/metallized PET/opaque ink layer/transparent PET heat seal with no other layers therebetween;

which is equivalent to the instantly claimed structure of:

transparent PET/adhesive layer/aluminum metallized PET/ink layer/hot melt layer;
wherein one of the opaque ink layers taught by Hein reads upon the colored adhesive layer directly applied to the metallized PET film and the other ink layer reads upon the instantly claimed ink layer. Hence, the two colored opaque ink layers on both sides of the metallized PET film taught by Hein read upon the instantly claimed adhesive layer and ink layer.

B. THE PRIOR ART COMBINATION DOES MAKE THE PRESENT INVENTION OBVIOUS

The Appellant first states that the Examiner has argued that the Hein patent teaches all elements of the claims except for the use of an adhesive layer. The Examiner respectfully disagrees with this statement. The Examiner takes the position that the Hein patent teaches an adhesive ink layer but fails to teach that the layer is white. The Examiner further notes that the secondary references are not relied upon for the presence of an adhesive layer, since Hein clearly discloses adhesive ink layers, but were solely relied upon to show that conventional adhesive or laminating inks comprising "two-part" or "two-component" laminating inks are known to provide excellent adhesion and printing on plastic films such as PET films.

1. ONE SKILLED IN THE ART WOULD COMBINE THE PRIOR ART PATENTS

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, and contrary to Appellant's arguments, Hein teaches the use of an adhesive ink layer or an ink layer with adhesive properties between the core and outer layers of the film. The Appellant argues that there "is no suggestion that the addition of further layers of the type claim in the present invention would address the issue of creating a high barrier", however, the Examiner is unclear as to what the Appellant is arguing given that the structure taught by Hein teaches all of the layers of the instantly claimed invention and there are no "further layers" claimed that are not disclosed by Hein. The Appellant further argues that it is the heat-seal layer applied over the ink layer that dispenses with any need to improve the ink layer in terms of an adhesive property. However, the Examiner again notes that Hein specifically teaches that preferred inks are those with adhesion characteristics and additionally notes that when the ink layer is applied over the entire surface of the metallized PET film as taught by Hein, it is the ink layer that adheres the outer heat-seal layer to the metallized PET film not the heat-seal layer itself as argued by the Appellant. If the ink layer did not have adhesive characteristics and was not an "adhesive" layer, the laminate would separate at the ink layer. The Appellant argues that there is no suggestion to combine the ink referred in the Hein patent with the specialized inks of the three secondary references, however, the Examiner disagrees and notes that the motivation is

clearly recited in the rejection and is based on adhesion. Hein teaches a PET laminate utilizing an ink layer between PET films wherein the ink is preferably one having adhesion properties but does not specifically recite a two-component adhesive. The secondary references teach that conventional adhesive or laminating inks comprising "two-part" or "two-component" laminating inks are known to provide excellent adhesion and printing on plastic films such as PET films. Hence, it is clear that one skilled in the art would have been motivated to utilize any conventional laminating ink composition wherein two-part or two-component laminating inks are known to provide excellent adhesion and printing on plastic films such as PET films as taught by Whyzmuzis et al or Murphy or Miyamoto et al.

2. ALL ELEMENTS OF THE INVENTION AS NOW CLAIMED ARE MADE OBVIOUS BY THE COMBINATION OF PRIOR ART

The Appellant again argues that the invention taught by Hein does not disclose separate and distinct layers of adhesive and white ink, and that one cannot equate an ink layer to an adhesive layer. The Appellant argues that though the ink layer taught by Hein has a pigment and adhesive properties, it is clear that an "ink layer" is not analogous to an "adhesive layer", wherein all the cited prior art references differentiate between these two separate elements and these terms are never used interchangeably. The Appellant states that disclosing "an ink layer does not automatically teach an adhesive layer to one skilled in the art, even though both layers have adhesive properties." However, the Examiner notes that the ink layer taught by Hein is more than just an ink layer printed on the surface of the film. Hein discloses that the ink layer is between two PET films and may be provided across the entire surface of the PET center film. As stated above, Hein specifically teaches that preferred inks have adhesion properties and given

that the ink layer is between the two PET films adhering them to one another, it is in fact an adhesive layer. In addition, the instant specification and claims fail to provide any definition of the broad term "adhesive layer" that would clearly differentiate the adhesive layer of the instant invention from the intermediate opaque ink layer with adhesive properties taught by Hein. Further, the art clearly recognizes the use of laminating inks to produce an ink layer that also functions as an adhesive layer as taught by the secondary references. Hence, the only difference between the opaque ink layer taught by Hein and the "two-component adhesive of white color" of instant claim 11 or the "two-component adhesive...mixed with a white pigment" of instant claim 12, is the "white" color. However, the Examiner maintains her position that the selection of color is well within the skill of an ordinary artisan and that one skilled in the art at the time of the invention would have been motivated to utilize white ink layers, an obvious species of colored opaque ink in the art, in the invention taught by Hein.

Next, the Appellant argues that the mention of the ink layer on one side of the metal-deposited layer does not make the specifically claimed adhesive layer with placement limitations obvious. In response, the Examiner notes that the layer placement is not obvious; it is clearly disclosed by Hein. Once again, the only difference is the "white" color and though the Appellant argues that the Hein patent nor the prior art combinations can disclose that "white" can be a color of a colored pigment, the Appellant fails to address the Examiner position that "white" would have been obvious.

Lastly, in response to the Appellant's arguments regarding the corresponding British and German patents, the Examiner agrees that the U.S. Patent and Trademark Office is not compelled by any other patent office of any other nation. It is also noted that the German patent was not

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relied upon by the Examiner and hence an English translation was not obtained. As for Appellant's comments regarding the indication of allowable subject matter on three separate instances in Office Actions on March 12, 2003, August 14, 2003, and January 26, 2004, the Examiner notes that the Appellant is incorrect. Allowable subject matter was NOT indicated in the August 2003 action or the January 2004 action. Regardless, the Examiner has the duty to perform further search and consideration prior to allowance.

III. SUMMARY

Based upon the foregoing reasons, the Examiner maintains her position that the instantly claimed invention is unpatentable over the teachings of the prior art, wherein the intermediate, adhesive ink layers taught by Hein read upon the claimed ink layer and claimed adhesive layer.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Monique R. Jackson

MONIQUE R. JACKSON
PRIMARY EXAMINER



Conferees:

Carol Chaney



/Jennifer Michener/

Quality Assurance Specialist, TC1700